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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.             | CONFIRMATION NO.            |
|---|-------------|----------------------|---------------------------------|-----------------------------|
| 10/517,619  | 12/23/2004  | Masao Oono           | 263785US0PCT                    | 7970                        |
| 22850 7590 02/05/2009<br>OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | EXAMINER<br>STULII, VERA        |                             |
|   |             |                      | ART UNIT<br>1794                | PAPER NUMBER                |
|   |             |                      | NOTIFICATION DATE<br>02/05/2009 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/517,619 | <b>Applicant(s)</b><br>OONO, MASAO |  |
|                              | <b>Examiner</b><br>VERA STULII       | <b>Art Unit</b><br>1794            |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-9, 11 and 14-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/07/2008</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The rejection of claims 1-14 under 35 USC § 112, second paragraph has been withdrawn in light of the claims' amendments filed October 22, 2008.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1-9, 11, 14-15 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Gorkum (EP 1,063,285) in view of Clare et al (US 4,720,389).**

In regard to claims 1, 15 and 18, Van Gorkum discloses a method for production of a beer-type beverage. Van Gorkum discloses that the "the malting step is completely abolished" (Abstract). Van Gorkum discloses preparation of wort by mixing starch-based glucose syrup (i.e. carbon source-containing syrup), amino acids and/or small peptides (i.e. nitrogen source), hops, water and coloring matter ([0016], [0017], [0037]). Van Gorkum further discloses fermenting the mixture "with a suitable yeast strain" ([0017]). Van Gorkum discloses that "[t]he present invention is based on the recognition that it is essential that the wort comprise certain carbohydrate and proteinaceous components. The composition has to be chosen in such a way that the yeast can ferment and produce alcohol from the sugars the second prerequisite is that the composition is such that the product has all desirable characteristics in terms of taste, mouthfeel, aroma, foam formation and –stability" ([0022]). In regard to claim 15, Van Gorkum further

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discloses production of the beer-type effervescent alcoholic beverage by adding hops (i.e. flavoring material/bittering substance) to the wort (i.e. prefermentation liquid) prior to the fermentation step ([0017], [0058], [0058]) for flavoring purposes ([0021]), and adding fiber such as malto dextrin in preparation of wort [0052].

In regard to claims 1, 15 and 18, Van Gorkum is silent as to addition of foam formation and/or head retention substance as recited. In regard to claims 15 and 18, Van Gorkum is silent as to the specific froth properties sigma value as recited.

Clare et al discloses a fermented malt beverage having improved foam stability and desirable lace, cling, and clarity achieved by adding xanthan gum and a galactomannan, e.g., guar gum or locust bean gum, or the glucomannan konjak gum (Abstract). Clare et al discloses that “a number of malt beverages or beers will produce a relatively good foam immediately after pouring, but the foams so produced are not as persistent as is usually desired by the consumers of such products. In addition, consumers desire a beer possessing a foam that will "cling" to the insides of a glass or mug in an attractive "lacy" pattern” (Col. 1 lines 5-11). ). Clare et al discloses that “it has now been found that the foam retention and lace/cling properties of a fermented malt beverage can be stabilized while minimizing haze formation by adding a combination of xanthan gum and galactomannan or the glucomannan konjak gum to the beverage” (Col. 1 lines 39-45).

Since Van Gorkum discloses beer-type beverage having foam formation characteristics, and Clare et al disclose using thickeners such as xanthan gum, guar, locust bean, fenugreek, Cassia, and tara gums as a suitable foam stabilizer for beers to

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obtain improved foam stability and desirable lace, cling, and clarity, one of ordinary skill in the art would have been motivated to modify disclosure of Van Gorkum and to employ thickeners as a foam stabilizer. One of ordinary skill in the art would have been motivated to do so, since Van Gorkum discloses production beer-type beverage having beer foam properties and Clare et al discloses production of beer-type beverage having improved foam stability.

In regard to the specific sigma value as recited (froth property indicator), it is noted that although the references do not specifically disclose every possible quantification or characteristic of its product, such as sigma value, this characteristic would have been expected to be in the claimed range absent any clear and convincing evidence and/or arguments to the contrary. The combination of references disclose the same starting materials and methods as instantly (both broadly and more specifically) claimed, and thus one of the ordinary skill in the art would recognize that the froth properties, among many other characteristics of the product obtained by referenced method, would have been an inherent result of the process disclosed therein. The Patent Office does not possess the facilities to make and test the referenced method and product obtain by such method, and as reasonable reading of the teachings of the references has been applied to establish the case of obviousness, the burden thus shifts to applicant to demonstrate otherwise.

In regard to claim 2, Van Gorkum discloses adding hops (i.e. flavoring material/bittering substance) to the wort (i.e. prefermentation liquid) prior to fermentation

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([0017], [0058], [0058]). Van Gorkum discloses adding hops for flavoring purposes ([0021]).

In regard to claim 3, Van Gorkum discloses that nitrogen source is an amino acid containing material ([0017], [0029], [0030]).

In regard to claims 4 and 5, Van Gorkum that carbon source containing syrup is obtained from potato, corn, or rice (page 6 claim 2).

In regard to claim 6, Van Gorkum discloses that nitrogen source (protein) is obtained from potato, corn, or rice (page 6 claim 3).

In regard to claim 7, Van Gorkum discloses that “the protein fraction may be extracted from any cereal source (or bran or fiber) as long as it contains amino acids, which are essential for the yeast that is used for fermentation” ([0029]).

In regard to claim 8, Van Gorkum discloses hop extracts [0037], hop pellets [0042], hops [Abstract], isomerized hop extract (iso-alpha-acid-extract) [0055], hop-oil emulsion [0058].

In regard to claim 9, Van Gorkum discloses caramel color [0037].

In regard to claim 11, Van Gorkum discloses beer-flavor beverage (Abstract).

In regard to claim 12, Van Gorkum discloses using fiber such as malto dextrin in preparation of wort [0052].

In regard to claim 19, Van Gorkum discloses boiling the wort, sedimenting to remove deposits, and cooling it prior to fermentation with yeast (Example 1 ([0038], Example 2 [0044], [0045])). In regard to claim 19, Van Gorkum also discloses fermenting

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the wort at 12°C for 14 days (Example 2 [0048]), or fermenting the wort at 12°C for 12 days (Example 3 [0059]).

**Claims 1-9, 11, 14-16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Gorkum (EP 1,063,285) in view of Kanazawa et al (JP 05038275).**

Van Gorkum is taken as cited above.

In regard to claims 1, 15 and 18, Van Gorkum is silent as to addition of foam formation and/or head retention substance as recited. In regard to claims 15 and 18, Van Gorkum is silent as to the specific froth properties sigma value as recited.

Kanazawa et al disclose production of a sparkling beverage having durable fine foam by addition of saponin (Abstract). Kanazawa et al disclose that saponin or saponin containing composition is derived from the tree *Quillaja saponaria* Mol (Abstract). Kanazawa et al disclose that beverage foam is “durable for the long time due to the surface tension-depressing effect of saponin” (Abstract).

Since Van Gorkum discloses beer-type beverage having foam formation characteristics, and Kanazawa et al disclose adding using saponin as a suitable foam retention substance for the foamy beverage to obtain improved foam, one of ordinary skill in the art would have been motivated to modify disclosure of Van Gorkum and to employ saponin as a foam stabilizer. One of ordinary skill in the art would have been motivated to do so, since Van Gorkum discloses production beer-type beverage having beer foam properties and Kanazawa et al disclose production of foaming beverage having improved foam stability and durability.

In regard to the specific sigma value as recited (froth property indicator), it is noted that although the references do not specifically disclose every possible quantification or characteristic of its product, such as sigma value, this characteristic would have been expected to be in the claimed range absent any clear and convincing evidence and/or arguments to the contrary. The combination of references disclose the same starting materials and methods as instantly (both broadly and more specifically) claimed, and thus one of the ordinary skill in the art would recognize that the froth properties, among many other characteristics of the product obtained by referenced method, would have been an inherent result of the process disclosed therein. The Patent Office does not possess the facilities to make and test the referenced method and product obtain by such method, and as reasonable reading of the teachings of the references has been applied to establish the case of obviousness, the burden thus shifts to applicant to demonstrate otherwise.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nakada et al (JP 2000060507) and Watabe (JP 2000014319) disclose a method for producing a foamable beverage using albumen peptide.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERA STULII whose telephone number is (571)272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JENNIFER MCNEIL can be reached on (571)272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steve Weinstein/  
Primary Examiner, Art Unit 1794

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